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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/498,261 | 02/03/2000 | Nicholas J. Mankovich | US000036 | 8558 |

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EXAMINER

ABDI, KAMBIZ

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/498,261

Applicant(s)

MANKOVICH ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10, 15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10, 15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The prior office actions dated;

05/06/2002
11/15/2002
02/24/2003
08/25/2003
12/29/2003

2. is incorporated herein by reference in addition to any intermediary communications. In particular, the observations with respect to claim language, response to previously presented arguments, and specific rejection reasoning.

- Claims 1-5, 7-10, 15, and 17-20 are pending.

Claim Objections

3. Claims 1 and 15 is objected to because of the following informalities: examiner would like to point out that
4. claim 1 seems to be by mistake have been modified as in line 9 of the claim it states; "the input device including *m...*" (Emphasis added).
5. claim 15 seems to be by mistake have been modified as in line 1 of the claim it states; "a purchase of an item *ma*," (Emphasis added)
6. Appropriate correction is required.

Response to Arguments

7. Applicant's arguments filed 19 April 2004 have been fully considered but they are not persuasive for the following reasons:

In response to applicant argument regarding rejection of Claims 1, 7, and 15 under 35 U.S.C. § 103 as being obvious over *Chen* in view of *Joseph*;

8. Examiner should emphasis that the reason for the appearance of lengthy citations of columns and lines has been the patent's short text and the examiners interest in showing the cited passages

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within the context of cited paragraphs. Also examiner has relied on the knowledge of the applicant of the understanding of the art by the applicant in discerning the relevant terms in relation to the claims.

9. However, for further clarity examiner will point out the exact phrase or word that would correspond to the applicants claim language in the following discussions.

10. As for claims 1, 7 and 15, applicant asserts he is not clear on how the citations that examiner has been pointing to in the references correspond and relate to the claims relevant terms such as "a content access device that is configured to receive content material simultaneously with an item identifier associated with the content material from a provider". Examiner would like to point out that applicant has argued on "the consumer receiver element 15" in page 12 of the remarks section of the response to the office action. There is no such element in the entire *Chen* patent.

11. Applicant is not clear about element 16 as a consumer receiver. It should be pointed that *Chen* clearly teaches the "receive content material ..." by the element 16 as well that *Chen* teaches that element 16 and 18 can be integrated into one unit as it is claimed in the claim. In addition, *Chen* teaches the "receive content material simultaneously with an item identifier associated with the content material..." *Chen* teaches this by the disclosure of the fact that to identify the content and related items to be purchased by the consumer, "in certain embodiments the consumer transmitter (content access device of combined element 16 and 18) can receive RDBS/RDS signals...and ancillary television band signals, which can be used to cause the consumer transmitter to identify for the consumer's convenience the music (Broadcast items) being played..." this clearly shows that information for identification is transmitted simultaneously with the "broadcast items" (See *Chen* Column 5, lines 56-68 and column 6, lines 1-8). Concluding that *Chen* teaches simultaneous reception of broadcast items as well as other identifying data along with the broadcast.

12. As for *Joseph* reference in support of *Chen* reference it clearly teaches the item identification as well as order transaction process in many different embodiments and methods as it has been claim by the applicant in the claims (Column 8, lines 52-64).

13. As for "purchase request processor" it seems to the examiner that applicant has not paid clear attention to the *Chen* or *Joseph* references in regards to the steps of processing a purchase by the

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consumer. They both clearly teach the use of the buy button to make a purchase (one click purchase). In *Chen* reference (see column 5, lines 37-41, element 30) "depressing an order button 30 or any similar mechanism to automatically transmit data to an order processing ..." and further in *Joseph* reference the remote control "buy button" does clearly teach the method of how to make a impulse purchase of an item related to a broadcast (See column 8, lines 53-64). It is unclear to the examiner what is meant by the applicant statement "but it is not seen that this input device functions or is connected as in the claims". The remote control of *Joseph* clearly is "operably coupled to the content access device..." (TV), it is also "operably coupled.." to the "purchase request processor..."(computer).

14. It should be noted by the examiner that in *Chen* reference the examiner has been clear on the element 30 of figure 3 is the buy button and element 18 as it has been described above separately or in combination with element 16 represent an input device. Same is true for *Joseph* reference as the remote control along with the TV and the computer create the elements specified above.

15. As for arguments submitted in regards to claims 3, 10, 17, and 18, the applicant's argument is not pointed towards any limitations or specific point in the claims. Applicant only mentions that examiners rejection of the above claims does not individually or in combination "teach or suggest the specific functions and connections for *various claim elements...*" (Emphasis added). There is no argument of what is specific and what is not specific to the claims and what is thought or not thought so the examiner can rebut such argument. The only item that might be construed as an argument is the attack of combination of arguments in the rejection of claims 17 and 18, which reads; "in a *remarkable and unmotivated* 4-way combination" (Emphasis added).

16. Examiner should point out that in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there are ample and specific references to the problems facing impulse purchase as well as the technology

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available at the time of the applicants claimed invention. It is also clear evidence from the teachings of the references specifically *Chen* reference the need and knowledge that has been available to one of ordinary skill in the art that could easily combine the references (for example see *Chen* column 1, lines 1-11).

17. Therefore, the examiner maintains the previous rejection of the claimed under U.S.C. 35 § 103 as they have been amended and presented in their current form.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-2, 4-5, 7-9, 15, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,737 to Humphrey D. Chen in view of U.S. Patent no. 5,819,034 to Joseph Kuriacose.

20. As per claims 1, 7, and 15, *Chen* discloses a receiving device, system, and method comprising:

- a content access device that is configured to receive content material simultaneously with an item identifier associated with the content material from a provider (See *Chen* abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14), and
- a purchase request processor, operably coupled to the content access device and an input device, that is configured to receive a purchase request from the input device and the item identifier directly from the content access device, and produces therefrom a processed purchase

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request (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14),

- a rendering device, operably coupled to the content access device, that is configured to render the content material (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14),
- the input device including a "buy" switch that is pre-programmed with a user's predetermined purchasing information in response to a single activation of the buy switch without the user being required to enter any additional data (See Joseph column 8, lines 34-68 and column 9, lines 1-1-2), and
- a purchase request buffer for storing at least one purchase request the in put device and the item identifier to facilitate a purchase of an item corresponding to the item identifier subsequent to the rendering device rendering the content material (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14), and
- wherein the content access device is further configured to communicate the processed purchase request to the provider (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).

What is not clearly defined by the Chen reference is the method used by the "single click purchase". However, Joseph clearly teaches one method that is well known in the e-commerce transactions to pay for a purchase by using "single click purchase". Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate a method of "single click" payment to Chen system in order to make it more convenient for the consumer for paying for the purchased items or information.

21. As per claims 2, 4-5, 8, 9, and 16, Chen clearly discloses all the limitations of claim 1, further; Chen discloses,

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- wherein the content access device is further configured to associate the purchase request and the item identifier based on a coincidence of a time of receipt of the purchase request and a time interval associated with the rendering of the content material (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).
- the purchase request processor is further configured to receive a transferred purchase request and a transferred item identifier, and to produce there from the processed purchase request.
- the purchase request processor is further configured to receive certification information associated with the purchase request (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14), and
- wherein the processed purchase request includes the certification information (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).
- a "buy" switch (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14), and
- wherein the purchase request from the input device is produced in response to an activation of the "buy" switch (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).

22. As per claim 19, Chen clearly discloses all the limitations of claim 15, further;
Chen discloses,

- transferring the purchase request to one or more intermediary devices (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14), and

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- wherein communicating the purchase request to the provider is via the one or more intermediary devices (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).

23. As per claim 20, Chen clearly discloses all the limitations of claim 15, further;
Chen discloses,

- further including attaching certification information to the purchase request that is communicated to the provider (See Chen abstract, column 1, lines 45-68, column 2, lines 1-30, column 3, lines 7-20, column 5, lines 23-68, and column 6, lines 1-14).

24. Claims 3, and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,737 to Humphrey D. Chen in view of U.S. Patent no. 5,819,034 to Joseph Kuriacose as applied to claims 1, 7, and 15 above, and further in view of John R. Anderson, Patent No. 5,991,601.

25. As per claims 3 and 10, Chen discloses all the limitations of claims 1 and 7 as discussed above. What Chen does not explicitly teach is the system to store content within a memory before access rights have been granted. However, Anderson clearly teaches a system and method for identification of a digital content based on a broadcast. Anderson teaches how to access a system to obtain such a digital item before usage right has been granted and store this digital content in a local memory (See Anderson column 8, lines 43-68 and column 9, lines 1-10 and 25-36).

26. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to simply provide content to the users within the local memory before the usage rights or authorization has been granted. One good example of this kind digital content would be the software items. Traditionally software is delivered through a medium such as floppy disks, CD-ROMs, Magnetic Tapes, or via the Internet. There are many software vendors that include the entire application or the game or any other content within the first delivery of content but limit the usage to either a limited time period or just a limited version of the application. Once the purchase process has been completed and an authorization has been received the entire digital content becomes available to the consumer.

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27. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,991,737 to Humphrey D. Chen in view of U.S. Patent no. 5,819,034 to Joseph Kuriacose as applied to claims 1, 7, and 15 above, and further in view of John R. Anderson, Patent No. 5,991,601 and Roy J. Mankovitz, Patent No. 5,949,492.

28. As for claims 17 and 18 Chen discloses all the limitations of claim 15 as discussed above. What Chen does not explicitly teach is the system to store content within a memory before access rights have been granted. Additionally, Chen does not explicitly teach the relationship between content identification and the time interval in conjunction with the rendering of the material. However, Anderson clearly teaches a system and method for identification of a digital content based on a broadcast. Anderson teaches how to access a system to obtain such a digital item before usage right has been granted and store this digital content in a local memory (See Anderson column 8, lines 43-68 and column 9, lines 1-10 and 25-36). The same argument of motivation can be stated as it has been discussed in the above claim.

29. In addition Mankovitz explicitly teaches a system for identification of the rendered material based on function of time in relation to the station that broadcasts the material (See Mankovitz column 2, lines 60-68 and column 3, lines 1-58). Identification of rendered material through a simultaneous broadcast of item identification along with the rendered material or usage of time, date, station call name combination or any combination thereof is a well known in the art and all aspects of these methods have been discussed in the above mentioned patents. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to incorporate a method of identifying a broadcast material based on relative information such as time, date, station call id in conjunction with other identifiable information from the broadcasting program.

30. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages

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and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

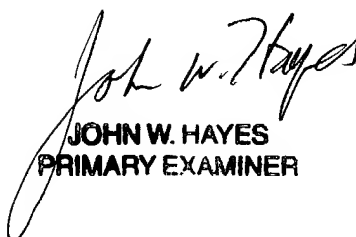
(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

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Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202

Abdi/K
July 15, 2004


JOHN W. HAYES
PRIMARY EXAMINER